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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Jeffrey A. Martin et al. Art Unit 1616  
Serial No. 10/059,564  
Filed January 29, 2002  
Confirmation No. 7937  
For OPTIMUM DENSITY TERMITE BAIT COMPOSITION  
Examiner Neil S. Levy

November 17, 2005

**REPLY BRIEF FOR APPELLANTS**

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SIR:

This brief is in response to the Examiner's Answer and is filed under 35 C.F.R. 41.41.

**A. RELATED APPEALS AND INTERFERENCES**

Appellant is unaware of any other pending appeals or interferences which may directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

**B. STATUS OF CLAIMS**

The Examiner agrees that the status of the claims as set forth in appellant's main brief is current.

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### C. ARGUMENT

1. The Examiner's Position in connection with the rejection of claims 1, 2, 4-6 and 8 over Richardson et al. under 35 U.S.C. 103(a) is predicated upon an impermissible "obvious to try" test.

In the Examiner's Answer, it is stated that this rejection is based on the disclosure by Richardson that the termite bait composition (lines 65-67) may be compressed into tablets or granular form. It is acknowledged in the Answer that Richardson does not specify density, but it is contended that

"Consideration of handling and safety (col. 3, first paragraph) provide an obvious basis for an operator to desire a compact form, less handling would be required. One could compress to any bulk density desired, up to the absolute density of the cellulose used. Thus, the specific density claim is obtainable, and not seen as an inventive concept".

The Examiner's arguments is lacking in any explanation as to why one skilled in the art would be led to investigate the matter of density, much less how the specific density recited in the claims on appeal "is obtainable". In the final analysis, the Examiner's position is predicated upon an "obvious to try" test, i.e. that it would be obvious to one skilled in the art to "try" and determine a useful or optimum density. As has been held for many years by the Court of Appeals for the Federal Circuit and its predecessor court, Court of Customs and Patent Appeals, "obvious to try" is not the proper standard to be applied under 35 U.S.C. 103. In one of the early decisions so holding, *In re Henderson*, 146 USP1 372 (CCPA 1965), the court stated (at 375-376):

"We are not impressed by the board's view, here urged by the solicitor, that because the ether additives would "inherently function" to produce the decreased sensitivity, the claimed blends are therefore obvious. Indeed, can it not be said that *all* functions of a substance are "inherent"? The fact remains that appellant has *discovered* that when certain ethers are blended with certain gasolines, the sensitivity of the resulting gasoline composition

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is less than the sensitivity of either the ether or the gasoline alone. The mere notion that such discovery would "flow naturally" from what *appellant* did does not mean that the discovery could be *predicted* from what the *art* had done. As we said in *In re Papesch*, 50 CCPA 1084, 315 F.2d 381, 187 USPQ 43, 51: "From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing." Or, as we stated recently in *In re Huellmantel*, 51 CCPA 845, 324 F.2d 998, 139 USPQ 496, 498-499:

\* \* \* This court has frequently stated that properties of chemical compounds must be considered in determining obviousness under 35 U.S.C. 103.

\* \* \* We think this also applies to such compositions as we have here, i.e., admixtures of two or more compounds. Therefore, the issue of obviousness in this case can be resolved only after considering the differences between the prior art and the claimed compositions chemically and in view of their pharmaceutical properties. \* \* \*

And, in a footnote to the foregoing statement:

\* \* \* The examiner concedes that appellant's compositions "shows improved results". The board accepts this as "fact", but concludes it is immaterial since "it is obvious to at least try" (our emphasis) to substitute one steroid for another in the prior art composition.

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We believe this reasoning, insofar as it negates consideration of properties in determining obviousness under section 103, flies in the face of the plain language of the statute as interpreted by this court \* \* \*. Section 103 says, *inter alia*, "the subject matter as a whole would have been obvious \* \* \*. Nothing is said about "obvious to try". Consideration of the subject matter "as a whole" in chemical cases requires comparison of properties, pharmaceutical or otherwise, as well as comparison of chemical structures.

We do not mean to imply that every variance in property of a new compound or composition will tip the balance for patentability where otherwise closely related compounds or compositions are involved. However, all relevant property differences *must be considered* in the light of the facts of each case in the determination of statutory obviousness. ""

See also *In re Tomlinson*, 150 USPQ 623 (CCPA 1966) and *In re Lindell*, 155 USPQ 521 (CCPA 1967). As underscored in *Henderson supra*, nothing is said in the patent statute about "obvious to try".

It is respectfully submitted, therefore, that the Examiner's rejection of claims 1, 2, 4-6, and 8 over Richardson et al. on the basis of an "obvious to try" test is untenable in view of the prevailing decisional law.

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2. Claims 1-8 are submitted to be clearly patentable over the Richardson et al. reference in view of the Minagawa et al. reference under 35 U.S.C. 103 since the density parameter optimized through the present invention was not heretofore recognized to be a result effective variable.

In the Examiner's Answer, it stated that no inventive concept is "evident" to the Examiner regarding "adjusting the density of a material" even though the prior art is completely silent concerning the density parameter and provides no clue that this parameter should be adjusted in any particular way. In this regard, reference is again made to Dr. Forschler's Declaration which establishes that the compressed cellulose tablet made in accordance with the present invention was highly preferred by the termites over the other two choices. The Examiner in the Answer states that the Forschler Declaration is directed at feeding differences, that the "cited brochure did not identify the tablets or the density of each test material, and it was not clear which material was better". Further, the Examiner stated that "even the best was only 33% effective". It is submitted that the Examiner has misread the true import of the Forschler Declaration. The Declaration clearly sets forth the three different test materials, two of which are not compressed and the third of which was compressed in accordance with the present invention to a density of not less than approximately 1.033 g/cc. Further, as the graph attached to Dr. Forschler's Declaration clearly shows, the compressed cellulose tablet of the present invention was highly preferred by the termites over the other two choices. There is no doubt as to which of the three materials was better and there is no support whatsoever for the Examiner's statement that "Richardson's Shitake/microcrystalline cellulose bait combination was better".

Moreover, the Examiner manifestly stretches the facts in asserting that Minagawa's pressure of 10 to about 500 kg/cm<sup>2</sup> is inclusive of appellants' pressures of between 516 and 1377 kg/cm<sup>2</sup>.

The Examiner's Answer also states that "Motivation for Richardson/Minagawa combination, is that of controlling termites, with optimization for the bait characteristics". Nothing in either of these references provides any hint that the

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density parameter is to be optimized to achieve the superior and unexpectedly good results achieved through the present invention. In other words, there is no recognition whatsoever in the prior art that density of the bait composition is a result effective variable. As held in *In re Antonie*, 195 USPQ 6 (CCPA 1977), inventions in which the parameter optimized was not recognized to be a result-effective variable are not considered obvious under 35 U.S.C. 103. As stated by the court in *Antonie* (at 8-9):

"The PTO and the minority appear to argue that it would always be *obvious* for one of ordinary skill in the art to *try* varying *every* parameter of a system in order to optimize the effectiveness of the system even if there is no evidence in the record that the prior art recognized that particular parameter affected the result. As we have said many times, *obvious to try* is not the standard of 35 USC 103. In re Tomlinson, 53 CCPA 1421, 363 F.2d 928, 150 USPQ 623 (1966). Disregard for the unobviousness of the results of "obvious to try" experiments disregards the "invention as a whole" concept of §103, In re Dien, 54 CCPA 1027, 371 F.2d 886, 152 USPQ 550 (1967) and In re Wiggins, 55 CCPA 1356, 397 F.2d 356, 158 USPQ 199 (1968), and overemphasis on the routine nature of the data gathering required to arrive at appellant's discovery, after its existence became expected, overlooks the last sentence of §103. In re Saether, 492 F.2d 849, 181 USPQ 36 (CCPA 1974).

In *In re Aller*, 42 CCPA 824, 220 F.2d 454, 105 USPQ 233 (1955), the court set out the rule that the discovery of an optimum value of a variable in a known process is normally obvious. We have found exceptions to this rule in cases where the results of optimizing a variable, which was known to be result effective, were unexpected good. In *re Waymouth*, 449 F.2d 1273, 182 USPQ 290

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(CCPA 1974); *In re Saether*, *supra*. This case, in which the parameter optimized was not recognized to be a result-effective variable, is another exception. The decision of the board is reversed."

It is submitted that the holding in *Antonie* is directly supportive of the patentability of claims 1-8 herein on the basis of closely similar factual situations. Thus, it is clear that the prior art did not optimize or suggest optimization of the density parameter in the context of the present invention.

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### CONCLUSION

Based upon the foregoing arguments and authorities, it is respectfully submitted that the Board should reverse the rejection of claims 1-8 on the grounds set forth in the final rejection of February 25, 2005 and allow these claims as involving optimization of a parameter not recognized as being result effective.

The Commissioner is hereby authorized to charge any government fees due to Deposit Account No. 19-1345.

Respectfully submitted,



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